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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/222,336	12/28/98	STORY	G 02541.P009

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EXAMINER	
RETTA, Y	
ART UNIT	**PAPER NUMBER**
2162	8

DATE MAILED: 06/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/222,336	Story et al.
Examiner	**Art Unit**
Yehdega Retta	2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Apr 26, 2001*

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8, 10-18, and 20-30* is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8, 10-18, and 20-30* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☑ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed April 26 2001. Claims 1, 11, 21 and 24 have been amended.

Response to Arguments

2. Applicant's arguments with respect to claims 1-8, 10-18, 20-30-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Claims 1, 11, 21 and 24, failed to teach how the cardinality is implemented. The specification does not teach how the license determines the number of playback devices the license can be used to authorize the playback. Applicant's specification, on page 5 lines 13-22 and on page 6 lines 1-3, states that the license management devices create licenses having an

associated cardinality that determines the number of playback devices that can be authorized by the license. The license is stored in a set of playback devices, where the number of playback devices in the set is less than or equal to the cardinality of the license. The license is also included in digital content that the license authorizes for playback... Playback devices that have a license that matches a license included in the digital content are authorized to play.... And on page 12 lines 16-23, the disclosure states that the license comprises a 32 bit group identifier...Each playback device storing a license belongs to a set of one or more playback devices storing the license. The set of playback devices is authorized to play digital content that include the license. The disclosure teaches that every playback devices that have the license stored are authorized to playback the digital content, whether they belong to a set of playback devices or not. The disclosure however fails to state or teach one of ordinary skill in the art how the cardinality indicates the number of playback authorized when the playback belongs to set of more than one playback devices. Since every playback devices storing a license belongs to a set of one playback devices storing the license, without this disclosure, one of ordinary skill can not practice the invention without undue experimention.

6. Dependent claims 2-8, 10, 12-18, 20, 22, 23, 25-30 are rejected since they depend on rejected claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1-8, 10-18 and 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Looney et al. U.S. Patent No. 5,969,283.

9. As per claims 1, 2 and 4-6, Looney et al (Looney) disclose creating a license having cardinality, the license created by a license management device; storing the license in a set of playback devices in response to a command from the license management device; storing the license in a digital contents and authorizing playback of the digital content with the playback devices including the usage right (see col. 6 line 29 to col. 7 line 27 and col. 7 line 60 to col. 8 line 19). Looney implies that one playback device is authorized to playback the content. Therefore teaches that the license indicates the number of playback device that is authorized to playback the content.

10. Claims 7 and 8, are rejected as stated above in claim 1 and it is further noted that the playback device being a hardware or software is an inherent feature.

11. Claim 10 is rejected as stated above in claim 1.

12. Claims 11, 12 and 14-16 are rejected as stated above in claim 1.

13. Claim 20 is rejected as stated above in claim 11 and it is further noted that the playback device being a hardware or software is an inherent feature.

14. Claims 21 and 22 are rejected as stated above in claim 1.

15. As per claim 24, Looney et al. (Looney) disclose license having a first cardinality being created by a license management device, the digital data signal further comprising a first digital audio content that is at least a subset of a digital audio programming, wherein a set of playback devices receive the digital data signal and authorize playback of the first digital audio signal if the license included in the data signal matches at least one license stored in the respective playback devices (see col. 2 lines 51-58 and col. 7 lines 8-59). Looney also discloses licenses stored in a payback device. Looney discloses the digital audio signal (package of data compressed songs and other software if applicable being tagged with a distinct serial number or other identifier and/or format that matches a pre-loaded serial number or format in the subscriber's particular center (see col. 7 lines 9-27). Looney discloses compact disc player, DAT or other audio playback medium being used by the center and the center determining whether the appropriate identification code and/or serial number matching that of the center is present. If not the downloading of the disc is terminated. Looney implies that one playback device is authorized to playback the content. Therefore teaches that the license indicates the number of playback device that is authorized to playback the content.

16. Claims 28 and 29 are rejected as stated above in claim 24 and it is further noted that the playback device being a hardware or software is an inherent feature (see col. 3 lines 6-10).

17. As per claim 30, Looney disclose the first digital audio comprising digital Video programming (see col. 3 lines 6-10 and col. 15 lines 6-23).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. Claims 3, 13, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Looney et al. U.S. Patent No.5,969,283, and further in view of Wyman U.S. Patent No. 5745879.

20. As per claims 3, 13, and 23, Looney does not specifically disclose at least one playback device belonging to a second set. Wyman disclose different nodes belonging to different accounts (see abstract and col. 1 lines 14-67). It would have been obvious to one of ordinary skill in the art at the time of applicant' invention to combine Looney's and Wyman's invention in order to provide flexibility or alternatives for varied licensing of parts or features of software packages as stated in Wyman (see col. 2 lines 18-34).

21. As per claims 25-27, Looney disclose access code authorizing the user's system playback the digital audio (see col. 2 lines 51-58). However it does not specifically disclose the cardinality being fixed, variable or unlimited, it is disclosed in Wyman (see col. 13 line 43 to col. 14 line 20). It would have been obvious to one of ordinary skill in the art at the time of applicant' invention to combine Looney and Wyman's invention in order to provide flexibility or alternatives for varied licensing of parts or features of software packages as stated in Wyman (see col. 2 lines 18-34).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ross et al. U.S.Patent No. 5,553,143, method and apparatus for electronic licensing.

Hellman U.S.Patent No. 4,658,093, software distribution system.

Nathan et al. U.S.Patent No. 5,182,126, Home digital audiovisual information recording and playback system.

Hershey et al. U.S.Patent No. 4,924,378, license management system and license storage key.

Griswold, U.S.Patent No. 5,940,504, licensing management systems and method in which datagrams including an address of a licensee and indicative of use a licensed product are sent form the licensee site.

Martin et al. U.S. Patent No. 5,355,302, system for managing a plurality of computer jukeboxes.

Glaser et al. U.S.Patent No. 5,793980, audio-on-demand communication system.

Conte et al. U.S. Patent No. 5,845,065, network license compliance apparatus and method.

Downs et al. U.S.Patent No. 6,226,618, electronic content delivery system.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436 The examiner can normally be reached on Monday-Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469.
Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED"or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner
Yehdega Retta
Art Unit 2162
June 20, 2001

ERIC W. STAMBER
PRIMARY EXAMINER